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AUG 11 2006

PATENT APPLN. NO. 10/802,059  
RESPONSE UNDER 37 C.F.R. §1.111

PATENT  
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REMARKS

Referring, first, to the objection to claims 1 and 5, the recitation of "the molded carrier being 1 to 5 seconds in average charge decay time for decay of 1,000 V to 5 V" in claims 1 and 5 has been amended to read "the carrier having an average charge decay time of 1 to 5 seconds for a charge decay of 1,000 V to 5 V". Applicants did not adopt the alternative recitation kindly suggested in the Action because the suggested recitation itself is unclear to applicants. The claims are now believed to be clear and removal of the objection to the claims is respectfully requested.

Claims 1, 2 and 4 to 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. (U.S. Patent No. 6,528,572; hereinafter "Patel").

Initially, it is noted that claims 1 and 5 have been amended to recite an aspect ratio of 5 to 1333 and to limit the synthetic resin to polyetheretherketone or polyetherimide. Claims 2 and 6 have been canceled. The limitation of an aspect ratio of 5 to 1333 is believed to be supported in the specification of the present application by the description on page 4, lines 16-20, of preferable carbon fibrils having an aspect ratio of at least 5 and

by the use in the Examples of a carbon fibril having an aspect ratio of from 13.3 to 1333.

Applicants respectfully submit that Patel does not support a case of *prima facie* obviousness of the carrier of the present invention as recited in the claims as amended which has an average charge decay time of 1 to 5 seconds for a charge decay of 1,000 V to 5 V and in which the aspect ratio of the carbon fibril of the carrier is limited to 5 to 1333 and the synthetic resin of the carrier is limited to a polyetheretherketone or a polyetherimide.

Patel describes that the conductive resin composition of its invention has a residual surface voltage of less than 5 volts, when measured about 8 seconds after application of a charge greater than about 1000 volts. A person of ordinary skill in the art is not directed to the choice of, i.e., is not motivated to select, a composition comprising a synthetic resin having a melting temperature of at least 300°C and which is a polyetheretherketone or a polyetherimide and comprising a carbon fibril admixed with the resin, wherein the carbon fibril is 3.5 to 75 nm in average diameter and 5 to 1333 in aspect ratio, with the expectation of obtaining a composition having a charge decay of

from 1000 volts to 5 volts within 1 to 5 seconds (as required in the present claims).

Removal of the 35 U.S.C. 103(a) rejection of the claims is believed to be in order and is respectfully requested.

Notwithstanding the insufficiencies of Patel to support a case of prima facie obviousness, applicants also note that the comparative data in the application show unexpected properties for the carrier of the present invention as now recited in the amended claims. These data are evidence that carbon fibrils, carbon fibers and carbon black do not produce equivalent results in a composition as recited in the claims and rebut the position of the Office.

Removal of the 35 U.S.C. § 103(a) ground of rejection is believed to be in order and is also respectfully solicited.

The foregoing is believed to be a complete and proper response to the Office Action dated May 11, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of

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time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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